

REMARKS

Claims 1-6, 11, 12, 21-26 and 32-34 are pending in the application and stand finally rejected.

Objections to the claims

Claim 5 stands objected to for being dependent on a rejected claim. Claim 5 has been canceled herein.

Rejection under 35 U.S.C §102

Claims 1-6, 11, 12, 21-26 and 32-34 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,458,349 to Aichelmann. In particular, the Examiner finds that, with regard to claim 1, Aichelmann discloses all of the claimed limitations except for choosing a threshold value in the range of about 50% to about 95% of the maximum number of failed symbols which can be corrected by error correction decoding the block of ECC encoded data, which the Examiner asserts as being "well within the scope of Aichelmann's invention since a person of ordinary skill in the art understands that a threshold value can be a fixed value or a range of values." Applicant respectfully disagrees with the Examiner's assertion, and further submits that the Examiner has failed to make a proper rejection under the Rules.

To support a proper 37 C.F.R. §102 rejection, a prior art document must teach each and every limitation of the rejected claim. The Examiner himself clearly acknowledges that Aichelmann does not teach at least the limitation of choosing a threshold value in the range of about 50% to about 95% of the maximum number of failed symbols which can be corrected by error correction decoding the block of ECC encoded data. Therefore, Aichelmann clearly cannot support a §102 rejection.

The Examiner appears to attempt to compensate for the deficiencies in Aichelmann's disclosure by asserting that the *scope* of Aichelmann encompasses the undisclosed limitations because a person of ordinary skill in the art understands that a threshold value can be a fixed

value or a range of values. Erstwhile, Applicant respectfully submits that the scope of the invention set forth in a prior art patent, which is typically understood to refer to that which is actually claimed, is accorded no weight whatsoever in any of the subparagraphs of 37 C.F.R. §102. Furthermore, whether a person of ordinary skill in the art understands that a threshold value can be a fixed value or a range of values or not is equally irrelevant to a 37 C.F.R. §102 inquiry, which concerns itself with that which is actually taught by the prior art, not that which was within the purview of the skilled person at the time the invention was made. The later inquiry belongs in a 37 C.F.R. §103 rejection, which is not asserted anywhere in the present Action.

Additionally, and for the sake of submitting as complete a response as possible, Applicant further notes the Examiner has made no showing in support of his assertion that a person of ordinary skill in the art understands that a threshold value can be a fixed value or a range of values, nor that the claimed range is a range that would be so understood by a skilled person. As clearly posited by MPEP 2143.03, “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).” (emphasis added) The Examiner has not made such a *prima facie* showing. At best, Applicant can understand that the Examiner is relying on facts within his personal knowledge in making this assertion regarding the knowledge of the skilled person. In this case, Applicant respectfully requests that the Examiner provide an Affidavit pursuant to 37 C.F.R. § 1.104(d)(2) in support of the assertion that a person of ordinary skill in the art understands that a threshold value can be a fixed value or a range of values.

In view of the above and the Examiner’s own statements, Applicant respectfully submits that the final rejection is fatally defective at least with respect to claim 1, and thus respectfully requests the Examiner to withdraw the finality of the present Action, reopen prosecution, and issue another Action allowing the claims or setting forth a proper rejection.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

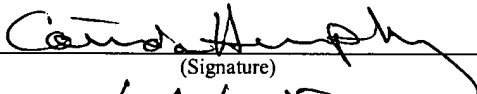
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(Date of Transmission)

Corinda Humphrey

(Name of Person Transmitting)

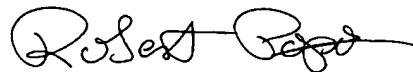


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Respectfully submitted,



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